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MAILED

NOV 29 2005

In re Application of: :
Satoshi Hoshino :
Application Serial No.: 09/895,173 :
Filed: July 2, 2001 :
For: **ELECTRONIC JOURNAL PREPARATION** :
SYSTEM AND ELECTRONIC JOURNAL :
PREPARATION METHOD :

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600
DECISION
ON PETITION

This is a decision on the petition filed November 10, 2005 and re-filed on November 17, 2005, pursuant to 37 CFR § 1.181 in regard to the Notice of Improper Request for Continued Examination (RCE).

Petitioner alleges that the Notice of Improper Request for Continued Examination dated October 27, 2005 is itself, improper. Petitioner states that two separate submissions were filed, one on August 8, 2005 and one on August 31, 2005, in response to the final Office action dated May 17, 2005. Furthermore, petitioner states that applicant checked the box on the request for continued examination form, filed October 13, 2005, requesting that previous amendments filed after the final Office action may be considered as a submission. Petitioner further urges that "...even if the supplemental amendment of August 31, 2005 was non-compliant...the remarks section of the Supplemental Amendment...constitutes a submission as required by 37 C.F.R. §1.114". Petitioner requests that the Notice of Improper Request for Continued Examination be withdrawn and that the RCE filed on October 13, 2005 be entered.

A review of the application file does in fact reveal two submissions subsequent to the final Office action of May 17, 2005. In an Advisory Action mailed September 6, 2005, the examiner indicated that the August 8, 2005 submission had been considered, but did not place the application in condition for allowance. In a separate Advisory Action mailed September 12, 2005, the examiner indicated that the August 31, 2005 amendment would not be entered as it raised new issues, and also noted that claim 7 was non-compliant as part of the claim was missing.

MPEP §706.07(h) [R-2] Request for Continued Examination (RCE) Practice, states in part:

III. INITIAL PROCESSING

D. Treatment of Proper RCE

If the conditions for filing an RCE have been satisfied, the technical support personnel will process the >proper< RCE. Any previously filed unentered amendments, amendments filed with the RCE, and any amendments filed prior to the mailing of the next Office action (after the RCE) will normally be entered. ****>All<** amendments filed as of the date the RCE is filed are entered in the order in which they were filed >in the absence of any specific instructions for entry.

VI. NOT FULLY RESPONSIVE SUBMISSION

If reply to a final Office action is outstanding and the submission is not fully responsive to the final Office action, then it must be a bona fide attempt to provide a complete reply to the final Office action in order for the RCE to toll the period for reply..

If the submission is a bona fide attempt to provide a complete reply, applicant should be informed that the submission is not fully responsive to the final Office action, along with the reasons why, and given a new shortened statutory period of one month or thirty days (whichever is longer) to complete the reply. See 37 CFR 1.135(c). Form paragraph 7.42.08 set forth below should be used.

Situations where a submission is not a fully responsive submission, but is a bona fide attempt to provide a complete reply are:

(A) Non-compliant amendment - An RCE filed with a submission which is an amendment that is not in compliance with 37 CFR 1.121, but which is a bona fide attempt to provide a complete reply to the last Office action, should be treated as a proper RCE and a Notice of Noncompliant Amendment should be mailed to the applicant. Applicant is given a time period of one month or thirty days from the mailing date of the notice, whichever is longer, to provide an amendment complying with 37 CFR 1.121. See MPEP § 714.03 for information on the amendment practice under 37 CFR 1.121. [emphasis added]

The Office's form PTO/SB/30, Request For Continued Examination (RCE) Transmittal states in part:

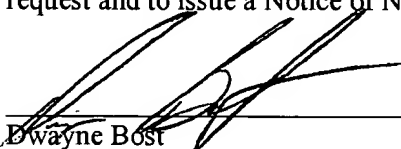
Note: If the RCE is proper, any previously filed unentered and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked. [emphasis added]

Given that Applicant's response of August 8, 2005 was considered by the examiner, but did not place the application in condition for allowance, this response was entered and thus in accordance with MPEP §706.07(h)(III)(D), would not constitute a proper submission. However, in accordance with MPEP §706.07(h)(IV), the August 31, 2005 amendment was not entered, and thus would be considered a proper submission for an RCE. However, it is noted that the August 31, 2005 submission was non-compliant given the partial claim 7. Therefore, in accordance with MPEP §706.07(h)(IV)(A), given that this was a bona fide attempt to provide a complete reply, a time period of one month or thirty days from the date of mailing of a Notice of Non-Compliance should have been set in order to allow applicant to correct the issue.

Accordingly, applicant's petition to have the Notice of Improper Request for Continued Examination be withdrawn and the RCE filed on October 13, 2005 entered, is Granted.

The file is being forwarded to the Technology Center's Technical Support Staff to process the RCE request and to issue a Notice of Non-Compliance.


Dwayne Bost
Special Programs Examiner
Technology Center 2600
Communications